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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,249	05/02/2006	Dorab Edul Bhagwagar	DC5080 PCT1	2598
137 7590 05/11/2009 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER PENG, KUO LIANG				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 05/11/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

# Office Action Summary

**Application No.**

10/544,249

**Applicant(s)**

BHAGWAGAR ET AL.

**Examiner**

Kuo-Liang Peng

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/1/08 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)  
Paper No(s)/Mail Date 2/1/08, 8/2/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Applicants' preliminary amendment filed August 2, 2005 is acknowledged. Claim 2 is deleted. Claims 4-10 are amended. Now, Claims 1 and 3-10 are pending.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 4 (page 4, 5<sup>th</sup> line from bottom), it is not clear as to what “(O(CR<sub>s</sub>Y<sub>2-s</sub>))<sub>i</sub>” refers to.

In Claim 4 (page 5, lines 7-8), it is not clear as to what “one of the Y groups is replaced by the Z group **bonding the R<sup>4</sup> group** to the cyclosiloxane of formula (II)” refers to. (Emphasis added) In other words, what is the relationship among Z, R<sup>4</sup> and formula (II)?

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-4 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmidt (US 5 366 809) in view of LeGrow (US 4 234 713).

Schmidt discloses an article having a hydrosilylation-curable pressure sensitive adhesive thereon. The adhesive comprises components A) to D). The pressure sensitive adhesive can be solventless. Schmidt further teaches the importance of the **viscosity** of the adhesive considering the preparation, **handling** and applications of the composition. (col. 1, line 16 to col. 2, line 48 and col. 7, line 61 to col. 8, line 19) Schmidt is silent on the use of a reactive diluent. However, LeGrow (US 4 234 713) points out the typical problem of adding a [non-reactive] solvent into a composition for **viscosity** reduction. (col. 1, lines 10-36) Accordingly, LeGrow teaches the incorporation of a reactive diluent in a hydrosilylation-curable composition. The motivation is to improve **handling** properties (e.g., lower **viscosity**) while **retaining** essential mechanical properties in

the cured composition. (Abstract, col. 1, lines 29-37 and col. 2, lines 1-24)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a reactive diluent into Schmidt's adhesive for reducing the viscosity of the composition, yet, maintaining the integrity thereof once cured with expected success.

6. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of above references, taken alone or in combination, teaches or fairly suggests the employment of the claimed reactive diluent.

7. The "X" reference cited in the international search report is not relied upon because of the following reason:

EP 108 208 does not teach or fairly suggest the incorporation of a reactive diluent in an **adhesive** composition. Instead, the reactive diluent is added in a **release** material.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
April 29, 2009

/Kuo-Liang Peng/  
Primary Examiner, Art Unit 1796

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